

REMARKS

Although the examiner has argued at length why creating graphs on a computer may have been well-known, the argument does not amount to a prima facie case that the visualization system as claimed would have been obvious. A prima facie case of obviousness requires that the references “teach or suggest ***all the claim limitations***” (MPEP §706.02(j), citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991), emphasis added), and the examiner has not shown this to be the case.

The examiner admits that “none of Gatto, Jones, Makivic, Official Notice, AAPA, Morningstar.com, E*Trade or Excel explicitly disclose the exact method for use in a visualization system comprising the [claimed] steps,” and the examiner has not contended or shown that the features of the claimed system were inherent in the underlying systems. To make up for this deficiency, the examiner essentially argues that, although none of these references discloses the claimed features, they were nevertheless present merely because computers were *capable* of performing them. This is not sufficient. Were the examiner’s theory to prevail, no invention that uses a computer to implement novel features could be patented because an earlier computer would certainly be capable of implementing those features, but for not being programmed to do so. The law cannot properly be read to support such a notion.

To put this in more concrete terms, not one of the graphing or data analysis packages mentioned by the examiner provides a way to produce the claimed visualization of probabilities. None of the market reporting services produced the claimed visualization of probabilities. Although general-purpose computers may have been capable of *displaying* such an image, without a tool programmed to *generate* one, the capabilities of the computers are irrelevant to the question of patentability. The inability of analysis software to *generate* the claimed visualizations demonstrates the inadequacy of stringing together many general references in an attempt to show that a specific improvement not found in any of the references would somehow have been obvious.

Additional comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

(1) One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant respectfully believes that the examiner has missed the point of the applicant's argument, namely that when *no reference* shows a given claim element, the combination of references can't possibly make a *prima facie* case that a claim including that element would have been obvious. Stating that the references must be taken together does not compensate for the fact that *each element* of the claim must be found in at least one of them or shown to be inherent, a burden which the examiner has not met.

The failure of the references to disclose required elements of the claim should be dispositive – a reason to combine is not relevant if the elements are not present to be combined in the first place. Previous replies and rejections in this case also debated the issue of a motivation to combine the references. The Supreme Court recently ruled in *KSR Int'l Co. v. Teleflex Inc.* that a more flexible test is required, but noted that the reason for alleging that the combination would have been obvious “should be made explicit.” 127 S.Ct. 1727, 1741 (April 30, 2007). The applicant presents the following response to the examiner's arguments, understanding that the examiner's position was based on an interpretation of the law that may no longer be current.

For an alleged reason to combine the references, the examiner repeats his earlier assertion that:

The practitioner's motivation would have been based on the desire to provide users with improved tools for effectively viewing historical estimates, analytical projections and recommendations regarding financial assets such as securities (Gatto, [0008])

and maintains that:

This statement is drawn from the motivations expressed in one of the prior arts of record in this case. The motivation meets the guidelines established by the court opinions cited above.

To the contrary, the following statement included in the examiner's long discussion of the law supports the applicant's point that the motivation stated by the examiner is irrelevant:

However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee. 277 F.3d at 1343-46;

The Supreme Court cited this same passage in *KSR* (attributing it to *In re Kahn*), to emphasize its statement that the analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed ... should be made explicit.” *KSR Int’l Co.*, 127 S.Ct at 1741.

Although “the analysis need not seek out precise teachings directed to the specific subject matter” (id.), the examiner’s asserted explanation of how motivation exists in this case is clearly a conclusory statement not supported by any articulated reasoning or rational underpinning. Simply put, the desire to provide improved tools may be a motivation to produce a *better* product, but this desire cannot be viewed as a motivation to achieve that goal using a *particular* improvement, especially when none of the references being combined have the claimed features. If such a motivation were sufficient to show obviousness, no patent on an improvement would ever have been granted.

The examiner admits that the cited references lack the features of claims 1 and 28, and the examiner has not shown that the missing features are described in or would have been suggested by the references. None of the many references describe and none would have made obvious, alone or in combination, the subject matter of the claims as a whole.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.


Applicant : Lisette Cooper et al.
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Respectfully submitted,

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Misha Kim Hill
Reg. No. 59,737

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906